IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: HODES

Application No.: 10/788,532

Filed: February 27, 2004

Title: Patent Analysis and Formulation
       Using Ontologies

Examiner: Patrick A. Darno

Group: 2163

Confirmation No.: 6928

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby requests review of the rejections in the above-identified application. This request is being filed with a Notice of Appeal. Review is requested for <u>at least</u> the reasons stated in the accompanying remarks.

REMARKS

1.   The Examiner is in clear error in asserting that claims 3 and 4 recite non-statutory subject matter.

In the Office Action mailed April 18, 2007, the Examiner has suggested amending claims 3 and 4 to recite "executing a program stored in a computer readable storage medium ..." to overcome the rejection.

The Examiner is in clear error here since claims 1 and 2, on which claims 3 directly or indirectly depend, recite statutory subject matter. Even the Examiner agrees. If claims 1 and 2 recite a statutory method, how can adding the limitation – in claim 3 – of a step of the method including "a computer executing a program" then make the method non-statutory?

That said, Applicant would agree to amend the claim as suggested if it is determined that this case should not go to appeal.

2.   The Examiner is in clear error in relying on the premise that "It is important to note that a patent claim is simply text" in contending that the claims are obvious.

A primary premise of the Examiner's prior art based rejections is that Roux discloses the subject matter of steps a), b) and c) of claim 1. This premise is used as a basis for rejecting claim 1, as well as for rejecting the remaining claims. In contending that Roux discloses the subject matter of steps a), b) and c) of claim 1, the Examiner has contended that "It is important to note that a patent claim is simply text."1 See Office Action dated April 18, 2007, page 4. Furthermore, the Examiner has also stated, at pages 17-18 of the Office Action:

> It is the Examiner's position that an operation that can be performed on one type of text document <u>can be</u> performed on any type of text document. It is a fact that a patent claim is simply text. This leads to the conclusion that any operation that can be performed on a text document can also be performed on the text of patent claim.

More generally, then, the Examiner is contending that disclosure of a genus (text) anticipates (i.e., "is simply") a species (claims). This contention is clear error and, therefore, all the prior art based rejections must fail, since all the prior art based rejections rely on this contention.

Applicant respectfully refers the Examiner to MPEP 2131.02, which is entitled "Genus-Species Situations" and sets forth a good discussion of the law in this area. The Examiner also seems to import an improper "obvious to try" assertion with regard to the argument that "any operation that can be performed on a text document can also be performed on the text of a patent claim.

With regard to the genus/species portion of the Examiner's argument, MPEP 2131.02 recites, "A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claim genus." If the Examiner had cited a reference that disclosed the species (claim) and cited this against a genus (i.e., text was recited), Applicant would agree that this may be a proper rejection under MPEP 2131.02, that the reference may be properly applied in this case. (This assumes, for the sake of argument only, that the Examiner would be correct in contending that a "claim" is a species of "text.")

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1 The Examiner has not contended that the Roux disclosure of processing "text" would render *obvious* the recited steps of processing "claims." Had the Examiner made such a contention, he would have been required to provide *additional* evidence of such obviousness, even under the recent <u>KSR</u> case.

However, the Examiner has argued completely the opposite, which is improper and has no legal basis whatsoever. The Examiner simply has not made a prima facie case that the Roux reference discloses processing a "claim."

The Examiner contends that it is the Applicant's burden to rebut the contention "with evidence or support." See pp. 17-18 of the Office Action mailed April 18, 2007, where the Examiner says that "Applicant did not provide any support for the allegation that the text of patent claims is different from the text of ordinary documents." It is the Examiner's initial burden to set forth a proper *prima facie* case, and this he did not do. In any event, a patent claim clearly has special properties that make it different from "ordinary text." In fact, Applicant has spent a good portion of the patent specification discussing the special properties of patent claims, specifically of element-by-element determinations relative to patentability, invalidity and infringement determinations. Roux discloses nothing of patent claims at all, let alone "element-by-element" determinations on patent claims.

Applicant recognizes that, in some special cases, a disclosure of a genus may properly be considered to anticipate a claimed species. For example, the case of Ex Parte A (a chemical case) is cited in MPEP 2132.02 for the proposition that (paraphrased), if one is able to "at once envisage" the species from the disclosure of the genus, then the genus may properly be considered to anticipate the claimed species. In the Ex Parte A case, the reference disclosed a "more limited generic class" that "consisted of about 20 compounds" and the compound recited in the claim was one of the 20 compounds. This is not analogous to the current situation, nor has the Examiner made any such assertion.

3. The Examiner is in clear error in contending, at page 4 of the Office Action mailed April 18, 2007, that "Stobbs discloses wherein a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance reads on the at least one patent claim."

Applicant has covered this point in some detail on page 11 of the Response filed February 27, 2004.

For example, Applicant argued that the portion of Stobbs cited by the Examiner (paragraphs [0108] and [0109]) relative to claim 13 merely discloses, at best, that module 188 is used to identify "likely candidates for possible infringement of the claims at issue" by using Internet search engine 186 to generate two sets of search results and identify "web pages that are in both sets of search results."

The search results are (1) results of presenting the claims as a query and (2) results of presenting product descriptions of the products covered by those claims. The "products" whose descriptions are used to determine the second search results are <u>not</u> potentially infringing products or potentially invalidating products. Significantly, the "products" are merely "a client's product that is covered by the claims at issue."

Furthermore, it is notable that not only is no ontology is involved but, further, Stobbs does not even disclose processing a "determined correspondence" of anything as contended by the Examiner, since Stobbs merely discloses identifying "likely candidates for possible infringement" and, presumably, would rely on a manual inspection and analysis to determine if there is actual infringement. In fact, even this cannot be presumed, since there is no disclosure whatsoever of what process would be taken to determine if there is actual infringement.

4.   The Examiner is in clear error in contending, at page 11 of the Office Action mailed April 18, 2007, that "Copperman discloses wherein determining a comparison includes determining whether there is a one to one correspondence between concept nodes in claim records and concept nodes in instance records."

Applicant has pointed out that "claim records" are mentioned nowhere in Copperman. The Examiner's response, at page 21 of the Office Action, completely ignores Applicant's assertion with regard to "claim records."

Furthermore, Applicant has further pointed out (see page 12 of the Response filed January 25, 2007) that the disclosure of Copperman does not support the Examiner's contention. Applicant specifically pointed out that:

> What Copperman actually states at column 15, lines 8-11, is:
>
> In one embodiment, classifications used by the text classifiers correspond one-to-one with concept-nodes within topic taxonomies. A separate text classifier is applied for each taxonomy.
>
> .... [C]lassifications corresponding one-to-one to concept nodes has nothing to do with determining a correspondence of concept nodes to concept nodes.

The Examiner stated, in the response on page 21 of the Office Action mailed April 18, 2007

> Surely if the invention only permits one-to-one concept node mapping then the invention has some means of determining if there is a one-to-one correspondence of concept nodes to concept nodes. If it had no means of determining if there is a one-to-one mapping, how would it know not to permit a two-to-one mapping? It is clear this determination must be present.

Unfortunately, Applicant may not have been clear enough in the argument. Cooperman discloses that classifications correspond one-to-one with concept nodes. Thus, as best

understood by Applicant, a text classifier, classifying text, would map text that is characterized by a particular classification to a concept node to which that classification corresponds.

However, the disclosure of mapping text to concept nodes (albeit, based on a classification determined for the text) is simply not the same as determining whether there is a one-to-one correspondence between concept nodes (remember, plural) of a claim record and concept nodes (again, plural) in instance records, which is what would typically be required in making determinations of unpatentability, invalidity and/or infringement. The cited portion of Copperman does not appear to disclose (or even suggest) such a feature.

CONCLUSION

It is respectfully submitted that Examiner's rejections are in clear error for <u>at least</u> the reasons discussed above and that this application is in condition for allowance. Notice to that effect is earnestly solicited.

Respectfully submitted,

/ASH/
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